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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,317	02/08/2001	Tsuguhide Sakata	1232-4681	4553

7590 09/23/2003
MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154

EXAMINER

ENG, GEORGE

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 09/23/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,317

Applicant(s)

SAKATA, TSUGUhide

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office action is in response to the amendment filed 7/1/2003 (paper no. 8).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 7-10 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapp et al. (US PAT. 6,073,192 hereinafter Clapp) and Rodriguez et al. (US PAT. 5,999,207 hereinafter Rodriguez).

Regarding claim 1, Clapp discloses a communication device (242, figure 7) for communicating in video and audio with another terminal device (262, figure 7) comprising an external connection interface (142, figure 5) for connecting with an external data processor (72, figure 5), communication means (170, figure 5) for exchanging information with the other terminal device, video input means (78, figure 5), video output means (76, figure 5), audio input means (80, figure 5), audio output means (220, figure 5), and control means (200, figure 5) for controlling an operation (col. 8 line 17 through col. 19 line 34). Note while Clapp teaches the communication device capable of providing stand-alone video conferencing capability to output

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video data to be displayed to the video output means in accordance with an operation, i.e., a first operation mode (col. 7 lines 17-29), and to transfer video data to be display to the external processor (72) in accordance with control commands received from the external data processor through the external connection interface, i.e., a second operation mode, when the communication device is coupled to the external processor (col. '7 lines 30-49) so that it recognizes Clapp obviously comprising mode-setting means for setting the first operation mode for unassisted operation or the second operation mode for operation under the control of the external processor and mode selecting means for automatically selecting between the first operation mode when the communication device is not connected with the external processor and the second operation mode when the communication device is connected with the external processor so that the communication device is automatically selecting either in the first operation mode for unassisted operation when the external data processor is not connected or in the second operation mode for operation under the control of an external data processor when the external data processor is connected. Clapp differs from the claimed invention in not specifically teaching the communication comprising operation means. However, it is notoriously well known in the art of a stand-alone video communication device comprising operation means in order to allow a user to access video communication functionalities with an input control device, for example see Rodriguez (abstract and col. 1 line 66 through col. 2 line 67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Clapp in having the operation means in the stand-alone communication device, as per teaching of Rodriguez, because it makes user friendly so that it allows the user to access video communication functionalities with the input control device.

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Regarding claims 2-3, Clapp teaches the communication device provides stand-alone video conferencing capability such that the communication device is automatically operating in the first operation mode after power is supplied (col. 7 lines 17-29 and col. 16 lines 19-50), and the communication device is operating in the second operation mode in accordance with a control instruction with the external processor when the communication device is coupled with the external processor (col. 7 lines 30-49 and col. 16 lines 51-66). Thus, it recognizes the mode setting means set the first operation mode in response to the connection state with the external processor changing to a substantially disconnected state.

Regarding claim 4, Clapp teaches the communication device capable of operating in accordance with a control signal control from the external processor (col. 7 lines 30-35).

Regarding claim 7, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claims 8-9, the limitations of the claims are rejected as the same reasons set forth in claims 2-3.

Regarding claim 10, the limitations of the claim are rejected as the same reasons set forth in claim 4.

Regarding claims 13-19, the limitations of the claims are rejected as the same reasons set forth in claim 1.

4. Claims 5-6 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapp et al. (US PAT. 6,073,192 hereinafter Clapp) and Rodriguez et al. (US PAT. 5,999,207

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hereinafter Rodriguez) as applied in claims above, and further in view of Kato et al. (US PAT. 5,898,824 hereinafter Kato).

Regarding claims 5-6, Clapp teaches the communication device comprising a recording medium (col. 8 line 25). The combination of Clapp and Rodriguez differs from the claimed invention in not specifically teaching recording management means for recording data to be recording in the external data processor when the recording medium has its space area less than a predetermined amount, and recording management information indicating that the data is recorded in the external processor on the recording medium, wherein the management means checks on the basis of the management information as to whether or not data to be reproduced exists in the recording medium and reproduces the data when it exists in the recording medium and request the external data processor to transfer the data when it exists in the external data processor. However, Kato teaches a method for improve a storage capacity of a communication device, i.e., a facsimile device, connected with a computer comprising detecting means, i.e., management means, for checking a residual amount of storage capacity of a first storage in the communication device, selecting a second storage in the computer for storing data when detecting means detecting that the first storage has it space area less than a predetermined amount, and means for determining whether the data is stored in the first storage or the second storage in order to reproduce the data being stored in the second storage when it exists in the computer (col. 10 line 50 through col. 14 line 67) so that it recognizes the detecting means recording management information indicating that the data is recorded in either the communication device or the computer. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Clapp

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and Rodriguez in having the management means, as per teaching of Kato, because it improves the storage capacity of the communication device.

Regarding claims 11-12, the limitations of the claims are rejected as the same reasons set forth in claims 5-6.

Response to Arguments

5. Applicant's arguments filed 7/1/2003 (paper no. 8) have been fully considered but they are not persuasive.

In response to applicant's argument that neither Clapp nor Rodriguez teaches or suggests "automatically selecting between a first operation mode and a second operation mode", it appears that Clapp teaches the communication device (242, figure 7) capable of operating as a stand-alone video conferencing system, i.e., a first operation mode, when the communication device is not coupled with a host computer system, i.e., an external processor, and operating as an enhanced video conferencing system, i.e., a second operation mode, when the communication device is coupled to the external data processor (72, figure 5) through the external connection interface for transferring video data to be display to the external processor in accordance with control commands received from the external data processor (col. 7 line 17-49), thereby it recognizes the invention as taught by Clapp obviously including mode selection means for automatically selecting between a first operation mode and a second operation mode and mode setting means for setting up the first operation mode for unassisted operation or the second operation mode for operation under the control of the external data processor depending upon the connection of the external data processor, such that the communication device is operating in the

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first operation mode for unassisted operation when the external data processor is not connected and the communication device is operating in the second operation mode for operation under the control of the external processor when the external data processor is connected. Note Clapp clearly teaches to automatically select between the first operation mode and the second operation mode and to set up the first operation mode and the second operation mode depending upon the connection of the external data processor, thus it recognizes the communication device is capable of automatically selecting between two operation modes. As a result, the broad claims are still being rejected by the combination of Clapp and Rodriguez, as well as the combination of the Clapp Rodriguez and Kato.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the present invention capable of a selection between a DVC mode and STB mode of operation using application software) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any response to this final action should be mailed to:

BOX AF

Commissioner of Patents and Trademarks

Washington D.C. 20231

Or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

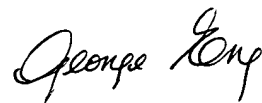
Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, V.A., Sixth Floor (Receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tuesday to Friday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz, can be reached on (703) 305-4870. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

A handwritten signature in black ink, appearing to read "George Eng". The signature is written in a cursive, flowing style.

George Eng

Examiner

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